



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,297	05/04/2001	Monique Gerardine Miranda Sommer	0142-0352P	9611

2292 7590 03/24/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2625

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/848,297	SOMMER ET AL.	
	Examiner	Art Unit	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 2/22/06.
- Claims 1-18 are pending, wherein claims 13-18 are newly added.
- Drawings filed on 5/1/01 has been considered and accepted by the examiner.
- Foreign priority filed on 5/4/01 has been considered and accepted by the examiner.
- Response to claim objections (claim 1, 8, 12) has been considered and accepted by the examiner.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/22/06 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hube et al (U.S. 5229814).

Regarding claim 1, Hube discloses a digital image production apparatus (*digital image forming system, fig. 1*) comprising:

- a print engine (*print module 95, fig. 2*);

Art Unit: 2624

- having a plurality of trays (*plurality of media trays 110, 112, 114, fig. 1 and fig. 2, col. 4, lines 40-50*) each of which is capable of accommodating different types of recording sheets (*i.e. transparency, standard paper, and etc., fig. 5*);
- a user interface (*user interface 52, fig. 1 & 2*); and
- an electronic control system (*controller 7, fig. 2*) for controlling print processing, including control of supply of recording sheets from the trays (*controlling print media from plurality of trays, fig. 5*) in accordance with sheet specifications (*print media specifications, fig. 5*) of print jobs (*print job with output media parameters/attributes, fig. 5-6*), wherein the control system has access to a memory (*main memory 56, fig. 2, col. 6, lines 23-60*) which stores for each tray the type of recording sheets (*col. 7, lines 20-24*) presently accommodated therein, and;
- wherein, when recording sheets of a type required for a job are not available (*requested print medias are not available, fig. 7a, steps 306-1 to 306-N, cols. 7-8*) in any of the trays, the control system: indicates, through the user interface (*UI, fig. 5-6*), the required type (*stock request 304, fig. 7a, col. 9, lines 30-45*) of recording sheet;
- selects an eligible tray (*"load requested stock in available tray" 324, fig. 7b*) that can accommodate the required recording sheets;
- invites, through the user interface, an operator to place recording sheets of the required type in the eligible tray (*steps 324, 326, and 328, fig. 7b*); and
- automatically (*automatically starts upon detection of the requested stock, fig. 7a*), in response to receiving a confirmation signal which confirms that the operator has completed the requested action (*printing will be resumed and/or started when media is loaded/detected, fig. 7b, col. 9, lines 20-65*), presumes that the installed recording sheets are of the required type (*requested media is loaded by operators, steps 324, 326, and steps 328, fig. 7b, cols. 9-10*) and stores information specifying the required type of recording sheet in a location of the memory (*memory 56, fig. 2*) associated with said eligible tray.

Regarding claim 2, Hube further discloses the apparatus according to claim 1, wherein, if at least one tray contains sheets of a type that is not needed (other trays

Art Unit: 2624

contain different media types, fig. 5-7) for the current job nor any other job scheduled for processing so as to represent at least one non-targeted tray, the control system selects one of the at least one non-targeted trays (select different/substitute media type if requested media is not available, fig. 5-7) as the eligible tray.

Regarding claim 3, Hube further discloses the apparatus according to claim 1, wherein the confirmation signal is a signal indicating that a start button (start button, fig. 5) of the apparatus has been actuated.

Regarding claim 4, Hube further discloses the apparatus according to claim 1, wherein the required type of recording sheet and the eligible tray are presented to the user in the form of a dialog on a display screen (dialog on display screen, fig. 5-6) of the user interface.

Regarding claim 5, Hube further discloses the apparatus according to claim 1, further including means for replicating the user interface on a display screen of a workstation (controller 7, col. 3, lines 28-42) connected to the printer through a network (remote network, col. 3, lines 28-42).

Regarding claim 6, the apparatus according to claim 5, wherein, when the workstation is online (connecting via a modem, col. 3, lines 28-67), the message indicating (UI, fig. 5-7) a request for loading recording sheets for a specific print job is forcibly offered to the user on the workstation, irrespective of whether or not a print monitor function is activated in the workstation (figs. 5-7).

Regarding claims 8-11 recite limitations that are similar and in the same scope of invention as to those in claims 1-4 above; therefore, claims 8-11 are rejected for the same rejection rationale/basis as described in claims 1-4.

Art Unit: 2624

Regarding claim 12 recite limitations that are similar and in the same scope of invention as to those in claim 1 above; therefore, claim 12 is rejected for the same rejection rationale/basis as described in claim 1.

Regarding claims 13-15, Hube further discloses wherein said job is a job that is about to start (fig. 7a), and the control system, in response to receiving said confirmation signal (confirmation of first stock request loaded, fig. 7a-7b), also starts up printing processing of the job (fig. 7a).

Regarding claims 16-18, Hube further discloses wherein said job is a job that has been started (fig. 7a), and the control system, in response to receiving said confirmation signal (confirmation of next stock requested loaded, fig. 7a-7b, and wherein print job as shown in fig. 7a contains plurality of requested stocks), also re-starts (fig. 7a shows each requested stock is processed individually and re-starts printing process each time a requested stock is loaded) print processing of the job.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hube et al as described in claims 1-6 above, and in view of Moro et al (U.S. 6327051).

Regarding claim 7, Hube discloses an image forming apparatus connected via network, but fails to explicitly teach an image forming apparatus is connected to at least "two" user terminals, and transmitting message regarding paper media to at least two terminals at different timings.

Art Unit: 2624

Moro, in the same field of endeavor for printing, teaches image forming apparatus is connected to at least “two” user terminals (fig. 10, col. 9, lines 60-67), and transmitting message regarding paper media (error messages, fig. 28 & 41) to at least two terminals (plurality of host computers, col. 9, lines 60-67) at different timings (errors messages can be sent virtual anytime depending on timings of occurrence).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hube as per teachings of Moro because of a following reason: (●) allowing multiple users to access a single image forming apparatus; thereby, reducing hardware costs; (●) by notifying printer’s errors to multiple users, the printer’s errors can be fix/response by different users and/or reducing downtime.

Therefore, it would have been obvious to combine Hube with Moro to obtain the invention as specified in claim 7.

Response to Arguments

Applicant's arguments with respect to claims 1, 8, and 12 have been considered but are moot in view of the new ground(s) of rejection (see claim 1 for details).

- Regarding claims 1, 8, and 12, the applicants argued the cited prior art of record (US 5229814 to Hube) fails to teach and/or suggest “automatically, in response to a confirmation signal which confirms that the operator has completed the requested action, presumes that the installed recording sheets are of the required type and stores information specifying the required type of recording sheet in a location of the memory associated with said eligible tray. In other words, the applicants argued Hube incorporates an additional step (checking if the requested stock matches the stock loaded in any of the trays) that was not necessary require by the applicant’s claimed invention/disclosure.

In response, the examiner fully disagrees with applicants’ arguments. First of all, the examiner would like to remind to the applicant that the term “presumes” is nowhere to be found in the original filed specification. Only relevant term “assume” is found within the original filed specification. Herein, the examiner interprets the term “presume” same as “assume”. If these two terms are different in definitions, clarification is required. Steps S5-S6 as shown in fig. 3 (applicants’ disclosure) is taught by step S324 (Hube’s

Art Unit: 2624

disclosure); steps S7 (applicants' disclosure) is taught by S326 (Hube's disclosure); step S8 (applicants' disclosure) is taught by S328 (Hube's disclosure); step S9 is taught by step 306-1 of fig. 7A (Hube's disclosure). In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *checking of loaded request stock is unnecessary*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicants' arguments are based upon an "*assumption*" that the operator has checked and verified that the loaded request stock is 100% true and accurate without further additional checking by the system controller. Clearly, "checking" method/step is performed by the operator, therefore, arguments "checking of loaded request stock is unnecessary" is found to be untrue and contradict. Hube also teaches the method of checking the loaded request stock (step 306-1 of fig. 7a after the stock is loaded from fig. 7b) to verify the loaded stock is true and accurate via using a system controller that the operator has loaded the right stock. In other words, applicants' and Hube' inventions are both involved checking but using a different method of checking; one using an operator to verify, the other using the system controller to verify.

Conclusion

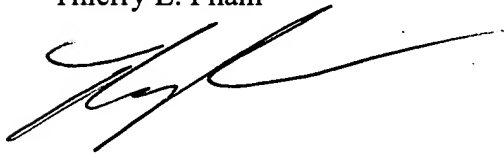
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



Primary Examiner
Gabriel Garcia
Gabriel Garcia